

All claims stand rejected. Claims 1, 3, 5, and 7-11 stand rejected as allegedly obvious under 35 U.S.C. 103(a) over Shahrebani (U.S. Patent 5,528,690) in view of Yamasaki (U.S. Patent 4,953,200). Claims 4 and 6 stand rejected as allegedly obvious under 35 U.S.C. 103(a) over Shahrebani (U.S. Patent 5,528,690) in view of Yamasaki (U.S. Patent 4,953,200), and further in view of allegedly well known prior art.

The Examiner also indicated that drawing changes are appropriate. Applicants acknowledge the contents of the Official Draftsman's notice, and will submit appropriate amendments. This course of action is taken after talking with the Examiner on this matter.

Standard for rejection under 35 U.S.C. 103

According to the Manual of Patent Examining Procedure (M.P.E.P.),

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all the claim limitations*. The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must both be found in the prior art*, not in the applicant's disclosure.” (emphasis added)¹

¹ M.P.E.P. §2143

Rejection over Shahrebani (U.S. Patent 5,528,690) in view of
Yamasaki (U.S. Patent 4,953,200).

Claims 1, 3, 5, and 7-11 stand rejected as allegedly obvious under 35 U.S.C. 103(a) over Shahrebani (U.S. Patent 5,528,690) in view of Yamasaki (U.S. Patent 4,953,200).

Claim 1

Claim 1 is directed to:

“a shell adapted to physically connect under a telephone, the shell having a port to connect to a telephone wire;

the shell containing interconnection logic operably connected to the port and a wire to connect to the telephone; and

a networking card in the shell for connecting to a personal computer, the networking card being operably connected to the interconnection logic, wherein digital data from the network card and voice data from the telephone can be alternately sent across the telephone wire.”

The cited references, which form the basis of the rejection, do not show many of the portions that make up Claim 1. Third, the motivation for combination of the references is apparently done on a non-objective basis. Thus, the combination is improper based on the reasons cited in the Action. Accordingly, the rejection of Claim is respectfully traversed.

The cited art does not have all the portions of the claimed invention.

The Examiner has cited various portions of Shahrebani and Yamasaki as comprising the claimed invention. As admitted in the Action, "Shahrebani fails to disclose a network card[.]" The Action further reads that "it [is] well known in the art to provide a network card . . . as taught by Yamasaki[.]" A cite to an extensive portion of Yamasaki, is described in the Action as "a data communication section (15) [that] inherently contains a data card[.]"

First, the Applicants are highly confused as to the basis for the inclusion of a network card. On one hand, the Examiner states "it [is] well known in the art to provide a network card", making the Applicants think that this is personal knowledge of the state of the art relied upon by the Examiner. If so, the form of the rejection is highly improper, as the only formal basis of the rejection are the two pieces of art.

Accordingly, if this is the case, Applicants respectfully traverse this rejection. The Examiner is hereby requested under M.P.E.P. 2144.03 to provide indicia of the applicability of the included missing portion in the shell of Shahrebani. Further, the inclusion of any extraneous art apart from the cited art must be made with an objective indicia of any of a motivation to combine. Such objective indicia of the motivation to combine, apart from statements made by the Examiner, is also hereby requested.

Second, if the Examiner is not relying on personal knowledge, but instead relies upon Yamasaki for the missing network card, Applicants also respectfully traverse this

possible prong of rejection of Claim 1. A careful reading of Yamasaki discloses no mention of a network card, nor any indication that a network card is envisioned.

The particular portion of Yamasaki that the Examiner equates the missing network card to is a communication section 15. Yamasaki notes that the “data communication section [15] [] realiz[es] data communication with the exchange[.]” Further, “[i]nformation of off-hook and on-hook from the key telephone is transferred to [a] control section through the data communication section 15[.]” A manual switch separates the data communication section from the data line.

Thus, the data communication section does not act in any way like a network card. Applicants would like to press the Examiner for specific operations of the cited data section, as found in Yamasaki, that performs *any function* associated with a network card.

Further, the Action reads that the Shahrebani art contains an “interconnected logic.” Applicants specifically request that the Examiner identify such interconnect logic in the Shahrebani art. The only remotely electrical function found in the Shahrebani art is a spool of wire. Applicants strenuously object to equating a spool of wire with any sort of logical function. Such a spool of wire does not perform any possible logic, let alone logic affiliated with communication interconnect functions. Absent such identification of “interconnect logic”, Applicants feel that this also points out a shortcoming in the rejection.

Accordingly, the portions of Claim 1 providing for “a networking card in the shell” and “interconnect logic . . . in the shell” are not present, among other items. These portions, among others, are not shown or suggested by Shahrebani or Yamasaki.

Therefore, for these reasons, among others, the rejection of Claim 1 is respectfully traversed.

Claim 7

Claim 7 is directed to a

“shell adapted for fitting under a telephone, the shell being wedged shaped to hold the telephone at an angle, the shell having extensions for physically connecting to the bottom of the telephone, the shell defining a first port region for connecting to telephone wire and a second port region for connecting to a personal computer.”

The Office Action reads that “the combination [of Shahrebani and Yamasaki] discloses everything as claimed[,]” but “fails to disclose a port to connect to the personal computer[.]” Later, the paper reads that “the Examiner maintains that it is well known in the art to provide a port to connect to the personal computer, as taught by Yamasaki.”

Again, the Applicants are confused, since the Examiner is maintaining in the same paragraph that the specific portions are not found in the combination, yet found in parts of the combination. Applicants specifically request for clarification on this inconsistency in the Action.

First, assuming *in arguendo* that Yamasaki supplies this portion, Applicant’s reading of this piece of art fails to disclose the coupling of the Yamasaki system to

anything remotely resembling a computer. Applicants request specifically where in Yamasaki this portion can be found. Otherwise, Applicants respectfully traverse this rejection.

Claims 3, 5, and 8-11

Claims 3 and 5 depend from Claim 1. Accordingly, Claims 3 and 5 contain all the portions of Claim 1, as well as other portions not found in Claim 1. For the reasons stated above in relation to Claim 1, among others, Applicants traverse the rejection of Claims 3 and 5.

Claims 8-11 depend from Claim 7. Accordingly, Claims 8-11 contain all the portions of Claim 7, as well as portions not found in Claim 7. For the reasons stated above in relation to Claim 7, among others, Applicants traverse the rejection of Claims 8-11.

Rejections over Shahrebani in view of Yamasaki, and f
further in view of allegedly well-known prior art.

Claims 4 and 6

Claims 4 and 6 stand rejected as allegedly obvious under 35 U.S.C. 103(a) over Shahrebani in view of Yamasaki, and further in view of allegedly well known prior art. The Office Action states that the Examiner, under M.P.E.P. 2144.03, “takes official

notice . . . that it is well known in the art . . . to provide electronics in the shell that allow for a wireless connection to the personal computer.”

Applicants, under M.P.E.P. 2144.03, traverse this rejection. Applicants also request “a reference in support of [this] position[,]” also under M.P.E.P. 2144.03.

Second, Claims 4 and 6 depend from Claim 1. The addition of this art cited in the official notice does not make up the shortcomings of the prior art with respect to Claim 1 above. Accordingly, the rejection of Claims 4 and 6 are respectfully traversed, for these reasons, among others.

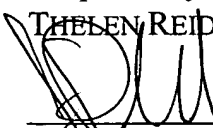
Conclusion

In view of the foregoing, consideration and an allowance of this application are earnestly solicited. It is believed that the Claims are all in form for allowance, and such a notice is asked of the Examiner. If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

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THELEN REID & PRIEST LLP
P.O. Box 640640
San Jose, CA 95164-0640
(408) 292-5800

Respectfully submitted,
THELEN REID & PRIEST LLP



J. Davis Gilmer
Reg No. 44,711